REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated March 16, 2010 ("*Office Action*"). At the time of the *Office Action*, Claims 1-32 were pending and rejected. Applicants have amended Claims 1, 7-14, 16-18, and 24-28. Applicants have cancelled Claims 6, 23, and 29. Applicants submit that no new matter has been added by these amendments. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Section 112 Rejection

The Examiner rejects Claims 1-32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Without conceding the veracity of the rejections and to solely to advance this case to issuance, Applicants have amended independent Claims 1, 14, and 28 to address the issues identified by the Examiner. Accordingly, Applicants respectfully request that the rejections of Claims 1-32 under 35 U.S.C. § 112 be withdrawn.

Section 103 Rejections

The Examiner rejects Claims 1-32 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013744 issued to Tsunenari et al. ("*Tsunenari*") in view of U.S. Patent No. 6,616,189 issued to Raming ("*Raming*").

Independent Claim 1 of the present Application, as amended, recites:

> A computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the steps of:
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> accessing item data representing at least one detail about the item;
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> accessing transaction data representing at least one detail about the transaction associated with the item including an identification of the transaction;
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> accessing customer data representing at least one detail about a customer associated with the transaction including a shipping origin;
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> accessing package data representing at least one detail about the package in which the item is expected to be shipped;

> using a computer operated by the merchant from whom the item was acquired or a specialized returns center associated with the merchant to process returns to correlate the item data, transaction data, customer data, and package data, with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center;
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> in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped, using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to generate a machine readable code for the return shipping label for shipment from the customer to the returns center, wherein the data represented by the machine readable code comprises a plurality of data points, at least a first of the plurality of data points included in the machine readable code representing at least the shipping origin of the package and at least a second data point in the machine readable code representing the identification of the transaction;
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> in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped from the customer to the returns center, using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of the choice of carrier, the machine readable code not associated with the carrier and in addition to a carrier-specified machine readable code also present on the shipping label; and
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> in response to receiving the package containing the item for return, scanning the machine readable code by the merchant or at the specialized returns center to correlate the machine readable code with one or more business rules for performing returns processing for the merchant associated with the transaction.

Whether considered alone or in combination, *Tsunenari* and *Raming* do not disclose, either expressly or inherently, each and every element of the claims.

For example, Applicants respectfully submit that the proposed *Tsunenari-Raming* combination does not disclose, teach, or suggest "wherein the data represented by the machine readable code comprises a plurality of data points, at least a first of the plurality of data points included in the machine readable code representing at least the shipping origin of the package . . .," as recited in Applicants' Claim 1. In the *Office Action*, the Examiner

acknowledges that *Tsunenari* does not disclose the recited machine readable code and instead relies upon *Raming*. (*Office Action*, page 7). However, Applicants respectfully submit that *Raming* does not disclose the machine readable code recited in Applicants' Claim 1.

The shipping label of *Raming* includes two machine-readable codes, identified by reference numerals 62 and 64 "of the type well known such as UPC bar coding." (*Raming*, Column 4, lines 51-55; Figures 1 and 8). Figure 1 and the accompanying description make clear that bar codes 62 and 64 are carrier generated bar codes such as those typical to a carrier such as USPS or UPS. The package also includes a scannable indicia 150 that is "applied to the face 152 of the container" and corresponding scannable indicia 116, which is present on the packing invoice, and scannable indicia 66 or 164, which is present on the shipping label. (*Raming*, Figures 1, 3, and 8; Column 5, lines 693-65; Column 6, lines 49-53; Column 7, lines 47-49; Column 4, lines 51-55). According to *Raming*, scannable indicia 150, 116, 66, and 164 are all alike. (*Raming*, Figures 1, 3, and 8; Column 5, lines 693-65; Column 6, lines 49-53; Column 7, lines 47-49; Column 4, lines 51-55). With regard to the disclosed scannable indicia, *Raming* merely indicates that a scanner is positioned to read the scannable indicia and "to verify that the packing list 14 which has been printed and applied to the container 16 matches the order corresponding to indicia 150." (*Raming*, Column 8, lines 41-47). Stated differently, "[t]he scanner 134 reads the scannable indicia 150 and communicates a signal corresponding to the indicia 150 to the controller which identifies the order corresponding to the indicia 150." (*Raming*, Column 7, lines 56-60). Thus, *Raming* merely discloses scanning the scannable indicia to identify a specific order. *Raming* does not disclose, teach, or suggest "wherein the data represented by the machine readable code comprises a plurality of data points, at least a first of the plurality of data points included in the machine readable code representing at least the shipping origin of the package . . . ," as recited in Applicants' Claim 1. Accordingly, the claim elements are absent from both *Tsunenari* and *Raming* and are not obvious over their proposed combination.

As another example, the proposed *Tsunenari-Raming* combination does not disclose, teach, or suggest "in response to receiving the package containing the item for return, scanning the machine readable code by the merchant or at the specialized returns center to correlate the machine readable code with one or more business rules for performing returns processing for the merchant associated with the transaction," as recited in Claim 1. As acknowledged by the Examiner on page 7 of the *Office Action*, *Tsunenari* does not disclose

the machine-readable code, and thus, necessarily does not disclose scanning the machine readable code by the merchant or the specialized returns center in response to receiving the package. Likewise, the only mention of returns in *Raming* is limited to the mere disclosure that "a return label 18 may be provided as a part of the system hereof." (*Raming*, Column 6, lines 34-36). Though *Raming* discloses that the return label preferably includes "bar code indicia corresponding to scannable indicia 116," there is no disclosure in *Raming* of scanning the scannable indicia by the merchant or the specialized returns center in response to receiving the package on return. Moreover, and as discussed above, *Raming* merely discloses that prior to the shipment of the item to the customer, a scanner is positioned to read the scannable indicia and "to verify that the packing list 14 which has been printed and applied to the container 16 matches the order corresponding to indicia 150." (*Raming*, Column 8, lines 41-47). Thus, *Raming* merely discloses scanning the scannable indicia to identify a specific order. *Raming* does not disclose "correlating the machine readable code with one or more business rules for performing returns processing for the merchant associated with the transaction" after the item is received on return, as recited in Claim 1. Accordingly, the claim elements are absent from both *Tsunenari* and *Raming* and are not obvious over their proposed combination.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim 1, together with Claims 2-13[1] that depend on Claim 1. For analogous reasons, Applicants request reconsideration and allowance of independent Claims 14 and 28, together with Claims 15-27 and 29-32[2] that depend on Claims 14 and 28, respectively.

Additionally, Applicants note the Examiner's statement with respect to Applicants' dependent claims that the "data or information" recited in Applicants' dependent claims "have been determined to be non-functional descriptive material (NFDM) because the information does not 'impart functionality when employed as a computer component', thus having no patentable weight." (*Office Action*, page 8). While Applicants do not admit that

[1] Applicants do not acquiesce to the Examiner's finding that Claims 2-13 and 19-27 recite information/data that is non-functional descriptive material. However, since Applicants have shown the independent Claims to be allowable, Applicants have chosen not to argue the dependent claims. Applicants reserve the right to argue these claims in the future should it become appropriate.

[2] Applicants do not acquiesce to the Examiner's finding that the business rules of Claims 29-32 are inherently disclosed in *Tibbs*. Rather, Applicants expressly dispute this finding and submit that for reasons similar to those described with regard to Claim 1, the claim elements recited in Claims 29-32 are not inherent from the disclosure of *Tibbs*.

the Examiner's attempt to dismiss these recited claim elements as non-functional descriptive material is proper, Applicants have amended at least dependent Claims 7-13, 16-18, and 24-27 to further recite operational steps that impart functionality when employed as a computer component. As just one example, Claim 7 has been amended to recite that "the customer data represents customer preferences, at least one customer preference comprising a customer-selected choice of carrier" and that the method further includes "using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label as required by the customer-selected choice of carrier." Thus, the method of Claim 7 is distinguishable from systems such as those disclosed in *Tsunenari* and *Raming* that do not include the recited functionality. Because neither reference nor their proposed combination discloses the operational steps recited in amended Claims 7-13, 16-18, and 24-27, Applicants respectfully submit that at least dependent Claims 7-13, 16-18, and 24-27 are allowable over the proposed *Tsunenari-Raming* combination. Accordingly, for at least these additional reasons, Applicants request reconsideration and allowance of Claims 7-13, 16-18, and 24-27.

New Claims 33-35 are Allowable

New Claims 33-35 have been added and are fully supported by the original specification. No new matter has been added. New Claims 33, 34, and 35 depend upon independent Claims 1, 14, and 28, respectively. Claims 33-35 are not obvious over the cited references, whether considered alone or in combination, because Claims 33-35 at least because Claims 33-35 include the limitations of their respective independent claims, which Applicants have shown above to be allowable.

Additionally, Claims 33-35 recite claim elements that further distinguish the art. For example, Claim 33 recites that:

> the transaction data further comprises identification of the merchant;
>
> at least a third of the plurality of data points included in the machine readable code representing the identification of the merchant; and
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> the method further comprises scanning the machine readable code by the specialized returns center in response to receiving the package containing the item for return to identify the merchant associated with the transaction.

Claims 34-35 recite certain substantially similar limitations. These combinations of features is not disclosed, taught, or suggested in the prior art of record.

In fact, and as acknowledged by the Examiner on page 7 of the *Office Action*, *Tsunenari* does not disclose the machine-readable code, and thus, necessarily does not disclose the machine readable code including a data point representing the identification of the merchant and scanning the machine readable code to identify the merchant. Though *Raming* discloses that the return label preferably includes "bar code indicia corresponding to scannable indicia 116," there is no disclosure in *Raming* that the bar code indicia includes a plurality of data points including the identification of the merchant. Rather, *Raming* merely discloses that a scanner is positioned to read the scannable indicia and "to verify that the packing list 14 which has been printed and applied to the container 16 matches the order corresponding to indicia 150." (*Raming*, Column 8, lines 41-47). Thus, *Raming* merely discloses scanning the scannable indicia to identify a specific order. *Raming* does not disclose, teach, or suggest "at least a third of the plurality of data points included in the machine readable code representing the identification of the merchant" and "the method further comprises scanning the machine readable code by the specialized returns center in response to receiving the package containing the item for return to identify the merchant associated with the transaction," as recited in new Claim 33 and analogously recited in new Claims 34-35. Accordingly, the claim elements are absent from both *Tsunenari* and *Raming* and are not obvious over their proposed combination.

For at least these reasons, Applicants respectfully submit that new Claims 34-35 are allowable over the prior art.

CONCLUSION

Applicants have made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 415-4820.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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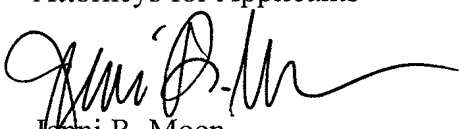
Attorneys for Applicants



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